REMARKS

In accordance with the foregoing, claims 1-43 have been cancelled without prejudice or disclaimer. New claims 44-86 have been added. Claims 44-86 are pending in the Application and under consideration. Support for the amendments to the claims may be found in the claims as originally filed, as well as in the specification. In particular, support for claims 44, 57, and 72 may be found in claims 1, 14, and 29, respectively, and at page 16, line 25 to page 18, line 19 and page 26, line 4 to page 28, line 8 of the specification. Support for claims 50, 64, and 79 may be found in claims 7, 21, and 36, respectively, and at page 19, lines 13-15 and page 33, lines 9-19 of the specification. Support for claims 56, 71, and 86 may be found in claims 13, 28, and 43, respectively, and at page 20, lines 5-8 and page 33, line 6 to page 40, line 9 of the specification. Reconsideration is requested based on the foregoing amendments and the following remarks.

Claim Rejections - 35 U.S.C. § 101:

Claims 1-43 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The rejection is traversed to the extent it might apply to new claims 44-86. Claims 44-86 recite technology such as, _inter alia_, "electronic article" and "client computer." Claims 44-48 are thus submitted be directed to statutory subject matter.

In any case, claims 1-43 were replaced with new claims 44-86 in the interest of compact prosecution only, and not for any reason of patentability. Claims 1-43, rather, were directed to statutory subject matter as filed originally, within the provisions of all applicable statutory and case law. In particular, 35 U.S.C. § 101 provides,

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Furthermore, as provided in State Street,

> Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result"-a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades. State Street Bank and Trust Co. v. Signature Financial Group Inc (149 F. 3d 1368, 1375 (Fed.Circ. 1998).

Since claims 1-43 did produce a useful, concrete, tangible result, as acknowledged in the Office Action at page 3, claims 1-43 were directed to statutory subject matter within the

provisions of <u>State Street</u>.

Furthermore, as provided in <u>State Street</u>,

The plain and unambiguous meaning of § 101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35, i.e., those found in §§ 102, 103, and 112, ¶2.

Since claims 1-43 did fall within one of the four stated categories of statutory subject matter, claims 1-43 were directed to statutory subject matter within the provisions of <u>State Street</u>.

In particular, claims 1, 7, and 13, as well as the claims dependent thereon, recited an apparatus for distributing information. Since claims 1-13 recited an apparatus for distributing information, claims 1-13 fell at least within the "machine" category of statutory subject matter provided for by 35 U.S.C. § 101. Furthermore, since claims 1-13 recited at least an "intensive information transmission unit, a "selective information receiving unit," and a "to-be-distributed information extraction unit," claims 1-13 must have fallen within the purview of the technological arts with respect to machines and databases.

Similarly, since claims 14, 21, and 28, as well as the claims dependent thereon, recited a method of distributing information, claims 14-28 fell at least within the "process" category of statutory subject matter provided for by 35 U.S.C. § 101. Furthermore, since claims 14-28 recited at least an "intensive information transmission step," a "selective information receiving step," and a "to-be-distributed information extraction step," claims 14-28 must have fallen within the purview of the technological arts with respect to processes.

Finally, since claims 29, 36, and 43, as well as the claims dependent thereon, recited a computer program containing instructions, claims 29-43 also fell at least within the "process" category of statutory subject matter provided for by 35 U.S.C. § 101. Furthermore, since claims 29-43 recited a computer program for performing at least an "intensive information transmission step," a "selective information receiving step," and a "to-be-distributed information extraction step," claims 29-43 must also have fallen within the purview of the technological arts with respect to either processes or machines.

Furthermore, as provided in <u>State Street</u>,

The repetitive use of the expansive term "any" in § 101 shows Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in § 101. Indeed, the Supreme Court has acknowledged that Congress intended § 101 to extend to "anything under the sun that is made by man." <u>Diamond v. Chakrabarty</u>, 447 U.S. 303, 309 (1980); see also <u>Diamond v. Diehr</u>, 450 U.S. 175, 182 (1981).

Since Congress intended § 101 to extend to "anything under the sun that is made by man", claims 1-43 must have been directed to statutory subject matter within the provisions of State Street. Finally, as provided in State Street,

> Thus, it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. See Chakrabarty, 447 U.S. at 308 ("We have also cautioned that courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed.'" (citations omitted)).

Since it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations, the further requirements listed at page 2 of the Office Action, i.e. "the recited process must somehow apply, involve, use, or advance the technological arts," are unlawful and ought to have been withdrawn. Still, as long as the Office presents these rejections, regardless of whether justified by law or not, a prudent Applicant must assess the real costs of overcoming the rejection relative to the necessarily speculative benefits to be gained by not amending the claims to suit the Office. Here, as in many cases, the real costs are perceived to outweigh the speculative benefits, and so the Office gets its way. Still, as discussed above, the Applicant is only replacing claims 1-43 with new claims 44-86 in the interest of comity, and not for any reason of patentability.

REJECTION UNDER 35 U.S.C. § 102:

Claims 1-43 were rejected under 35 U.S.C. § 102(e) as anticipated by Jacobs et al., US 2004/0039784 (hereinafter "Jacobs"). The rejection is traversed to the extent it might apply to new claims 44-86.

According to at least one embodiment of the invention, an apparatus for distributing information and a computer program makes it possible for users to obtain information efficiently by, for example, selecting necessary information from among a lot of information stored in a database, and acting for users in arranging of the selected information. As Jacobs, on the other hand, describes at paragraph [0148],

> The PlayList Request, which is sent by the Eudora client to the PlayList server 302 in order to initiate the ad fetch process, is not a simple burst of binary code. The PlayList Request is a block of extensible markup language (XML) code employed to provide the server 302 with sufficient information to build or select the proper New PlayList for the user. The information in the PlayList Request is shown in the following table.

14

9 PARAMETER DESCRIPTION UserAgent This is a string identifying the application requesting the PlayList, its version number, and the platform on which it is running. PlayList(s) This identifies the PlayList(s) that the client is currently using. This may have multiple values if the client is working off more than one PlayList. Entry A list of the id's of the ads recently shown by this client. The entries are nested inside the PlayList to which they belong. Each entry can have zero or more of the following associated attributes or types (the number following the equal sign (=) indicates an exemplary value attached to the attribute which is used to achieve the description of the entry attributes provided below): Active = "0" The ad is no longer being shown. IsRunout = "1" The ad is a runout ad. This saves the server having to do a lookup on the ad. IsSponsor = "1" The ad is a sponsorship ad, to be shown in place of the QUALCOMM logo. See FIG. 3B. IsButton = "1"" The ad is a toolbar button. Deleted = "1"" The ad has been hidden by the user. This is allowed only for toolbar ads. FaceTime This lists the amount of face time the user has used in the last seven calendar days. This allows the server to determine how many ads the client is likely to be able to display. The value for the current day is the greater of today's value (see faceTimeUsedToday) and last week's value for today. FaceTimeLeft This is a total of the amount of face time requested by the ads still left in the client's ad cache. FaceTimeUsedToday This is the amount of face time the client has used toward displaying ads today. It can be used by the server to determine whether a date-critical ad can be shown today. DistributorID This id is used for the bounty system, so that the PlayList Server can identify and credit, commission or otherwise reward the ISP or other organization that distributed this copy of Eudora. Pastry This is a cookie the PlayList Server gave to the Eudora e-mail client in the past. It could contain any state information/ settings the server wishes to save. Profile Profiling information originally entered on the software provider's web page and subsequently/concurrently stored with the e-mail client. Screen.height The height of the display on which the ads are shown, in pixels. Screen.width The width of the display on which the ads are shown, in pixels. Screen.depth The color depth of the display on which the ads are shown, in colors/bits per pixel. PlayListVersion The version # of the PlayList routine employed by this particular client.

Thus, in Jacobs, the PlayList Request is sent by the Eudora client to the PlayList server 302 in order to initiate the ad fetch process. The PlayList Request provides the server 302 with sufficient information to build or select the proper New PlayList for the user. The user never gets to select either the PlayList or the advertisement to be downloaded. This is to be contrasted with the claimed invention, in which users select necessary information from among a lot of information stored in a database.

Claims 44, 50, 57, 64, 72, and 79 in particular, recite substantially,

"transmitting a summary of a plurality of electronic articles stored in the article database to the client computer."

Jacobs, on the other hand, neither teaches, discloses, nor suggests "transmitting a summary of a plurality of electronic articles stored in the article database to the client computer,"

as recited substantially in claims 44, 50, 57, 64, 72, and 79. As Jacobs, rather, describes at paragraph [0025],

> In one aspect, the present invention provides software, for use on a client device that is configured for communications with at least one remote source of advertisements via a communications network, which instantiates an advertisement download function that downloads advertisements from the at least one remote source, during one or more advertisement download sessions, an advertisement storage function that stores the downloaded advertisements on a storage medium associated with the client device, an advertisement display function that effects display of at least selected ones of the stored advertisements on a display associated with the client device, an audit function that compiles ad-related statistical data relating to the downloaded advertisements, wherein the ad-related statistical data includes display event-related data regarding advertisements that were displayed during a prescribed audit interval, and an audit data transmit function that transmits the ad-related statistical data to a prescribed server system. Advantageously, the audit data transmit function generates a send audit data display window that requests the user's permission to transmit the ad-related statistical data to the prescribed server system, and the audit data transmit function transmits the ad-related statistical data only in response to a user's grant of permission to do so.

Thus, in Jacobs, the *software* instantiates an advertisement download function that downloads advertisements from the at least one remote source. This is to be contrasted with claims 44, 50, 57, 64, 72, and 79, which recite substantially "transmitting a summary of a plurality of electronic articles stored in the article database to the client computer."

> Furthermore, as Jacobs describes at paragraph [0059],

> Referring now to specific drawings, FIG. 1 illustrates an exemplary system configuration 10 which is suitable for carrying out the functions according to representative embodiments of the present invention. Although the representative embodiment will be generally described with respect to an electronic mail (e-mail) system where a number of users can create, send, receive and read e-mail messages, the present invention is not so limited. For example, the present invention is equally applicable to a personal digital assistant (PDA) incorporating specialized software for receiving stock quotations via a wireless network. Thus, the principles of the present invention should not be regarded as limited solely to e-mail systems; the principles of the present invention apply to on-line services where a provider, e.g., a software provider, desires to make its software available to users using a variety of payment options for a core set of software functions.

Thus, in Jacobs, a *provider*, e.g., a software provider, desires to make its software available to users using a variety of payment options for a core set of software functions. This is to be contrasted with claims 44, 50, 57, 64, 72, and 79, which recite substantially "transmitting a summary of a plurality of electronic articles stored in the article database to the client computer."

> Claims 44, 50, 57, 64, 72, and 79 recite substantially further,

"receiving a specification from the client computer in response to the summary, the specification specifying which electronic article is selected by the client computer."

Jacobs neither teaches, discloses, nor suggests "receiving a specification from the client computer in response to the summary, the specification specifying which electronic article is selected by the client computer," as recited substantially in claims 44, 50, 57, 64, 72, and 79. In Jacobs, rather, the *software* instantiates an advertisement download function that downloads advertisements from the at least one remote source, as discussed above. This is to be contrasted with claims 44, 50, 57, 64, 72, and 79, which recite substantially "receiving a specification from the client computer in response to the summary, the specification specifying which electronic article is selected by the client computer."

As Jacobs describes further at paragraphs [0173],

The "action" value determines what function the user wishes to perform. The software provider then appends various other query parts to the URN, suitably %-escaped, i.e., separated by a percentage (%) or ampersand (&) symbol (for example), according to the chart illustrated in FIG. 19. A brief discussion of each type of web page referenced in FIG. 19 is provided immediately below.

13 PAYMENT This web page should take the user's credit card WEB PAGE info, name, e-mail address, and whatever other information the software provider wants to compile about its users. It will also ask them for a question and answer for use if they ever lose their payment code. It should return, e.g., display and also e-mail, their official registration name and registration code. FREEWARE This web page should take the same info as the REGISTRATION Payment web page, minus the credit card WEB PAGE information. It should send back (that is, display and also e-mail) their official registration name and registration code. ADWARE This web page should take the same info as the REGISTRATION Payment web page, minus the credit card WEB PAGE information. It should send back (that is, display and also e-mail) their official registration name and registration code. BOX This web page exists to accept registrations REGISTRATION generated by Box or updater installers. It should WEB PAGE simply accept the user's code, validate it, mail it back, and display a "thank you for registering" page or dialog box. LOST CODE This web page helps users find their registration WEB PAGE codes. When they register/pay, they'll be asked to provide their name, e-mail address, and a question and answer. When they come to the lost code page, they'll be asked for name and address, and if that matches, they'll be asked their question. If all that goes well, their RegCode will be mailed to them. If they can't receive mail, they'll have to call. UPDATE This web page should list the updates that are WEB PAGE available to the user. Ideally, it would list only those updates the user does not already have, and clearly indicate which updates are free and which updates the user needs to pay for. This web page will be downloaded to the user's system from time to time and displayed "off-line" in Eudora, and so it should be kept small. ARCHIVED This web page should list all versions of Eudora, so VERSIONS that users can download whatever they happen to WEB PAGE need. PROFILE The purpose of this web page is to collect

WEB PAGE demographic information so that ads delivered to the user can more precisely targeted by advertisers. At this page, the user will be asked a series of questions about his/her personal preferences, habits, etc., e.g., buying habits, sleeping habits, preferences in clothing, etc. No information identifying the user is to be collected on this page! The information will be reduced to a cookie, mailed to Eudora and stored as part of the user's settings in the Eudora directory (folder). The procedure for accepting a profile is the same as the procedure for accepting a registration code, detailed below. SUPPORT The software provider will need several web pages WEB PAGES for resolving user problems. For these pages, the software provider will use the "topic" part of the query to direct users to situation-specific help as needed.

Thus, in Jacobs, a web page collects WEB PAGE demographic information so that ads *delivered* to the user can more precisely targeted by advertisers. This is to be contrasted with claims 44, 50, 57, 64, 72, and 79, which recite substantially "receiving a specification from the client computer in response to the summary, the specification specifying which electronic article is selected by the client computer.

Finally, claims 44, 50, 57, 64, 72, and 79 recite substantially,

"uploading the electronic articles compiled at the compiling to a predetermined website."

Jacobs neither teaches, discloses, nor suggests "uploading the electronic articles compiled at the compiling to a predetermined website," as recited substantially in claims 44, 50, 57, 64, 72, and 79. As Jacobs, rather, describes at paragraph [0062],

> Referring again to FIG. 1, each of the client computers 100a, 100b, . . . , 100n can selectively communicate with any of the servers, e.g., servers 301-304, via the network 200. In the computer system 10 depicted in FIG. 1, each of the servers performs a specialized function. In an exemplary case, server 301 performs a registration function, i.e., accepts registration information from each client computer (as discussed in greater detail below), server 302 provides PlayLists to the client computers 100a, 100b, . . . , 100n, server 303 provides the advertisements designated in the PlayLists, and server 304 acts as a conventional e-mail system server system, i.e., provides both the incoming e-mail server and the outgoing e-mail server. It should be mentioned that only servers 301 and 302 need actually be under the direct control of the software provider, e.g., QUALCOMM INCORPORATED in the preferred embodiment, although server 303 advantageously may be under the control of the software provider as well. It should also be mentioned that the reference to software should not be construed as limited to disk based software; the term "software" should be broadly interpreted as instructions carried out by a processor, whether these instructions are read from a dynamic memory or stored as firmware in an read only memory (ROM) or other variants of such a device.

Thus, in Jacobs, server 301 performs a registration function, i.e., accepts registration information from each client computer (as discussed in greater detail below), server 302 provides PlayLists to the client computers 100a, 100b, . . . , 100n, server 303 provides the

18

advertisements designated in the PlayLists, and server 304 acts as a conventional e-mail system server system, i.e., provides both the incoming e-mail server and the outgoing e-mail server. This is to be contrasted with claims 44, 50, 57, 64, 72, and 79, which recite substantially "uploading the electronic articles compiled at the compiling to a predetermined website." Claims 44, 50, 57, 64, 72, and 79 are thus submitted to be allowable.

Claims 45-49, 51-55, 58-63, 65-70, 73-78 and 80-85 depend from claims 44, 50, 57, 64, 72, and 79, respectively, and add further distinguishing elements. Claims 45-49, 51-55, 58-63, 65-70, 73-78 and 80-85 are thus also submitted to be allowable.

Claims 56, 71, and 86:

Claims 56, 71, and 86 recite substantially,

"transmitting the electronic articles compiled at the compiling to the client computer."

Jacobs neither teaches, discloses, nor suggests "transmitting the electronic articles compiled at the compiling to the client computer," as recited substantially in claims 56, 71, and 86. In Jacobs, rather, the *software* instantiates an advertisement download function that downloads advertisements from the at least one remote source, and a web page collects WEB PAGE demographic information so that ads delivered to the user can more precisely targeted by advertisers, as discussed above. This is to be contrasted with claims 56, 71, and 86, which recite substantially "transmitting the electronic articles compiled at the compiling to the client computer." Claims 56, 71, and 86 are thus submitted to be allowable.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 44-86 are allowable over the cited references. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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